

REMARKS

Claims 1-12 were previously cancelled. Claims 13-19 and 22-26 have been withdrawn. Claims 20, 21, and 27-37 remain pending.

Response to Election of Species Requirement

In response to the original Restriction Requirement, applicants elected Group III drawn to methods of preparing a peritoneal dialysate having reduced carbonyl content by using a carbonyl compound-trapping agent. That election encompassed original claims 8 and 9. Further, as pointed out within the response to the Restriction Requirement, the original claims were cancelled and new claims 13-37 were added. Among these, claims 13-19 and 22-26 have been withdrawn as being drawn to a non-elected invention. Hence, claims 20, 21, and 27-37 are now pending in the present application.

Within the current Election of Species Requirement, the Examiner specifically indicated that the present application contains claims directed to more than one species of the generic invention as follows:

Methods for preparing a peritoneal dialysate having reduced carbonyl content by using

- i. an adsorbent cartridge that traps carbonyl compounds with a carbonyl compound-trapping agent;
- ii. a carbonyl compound-trapping agent that is not used in conjunction with an adsorbent cartridge;
- iii. a carbonyl compound-trapping agent selected from one of groups (1) - (31), set forth on page 8, line 20 to page 10, line 15 of the specification.

The Examiner asserts that the above species do not relate to a single inventive concept under PCT Rule 13.1 because they lack the same or corresponding "special technical features". In support of this argument, the Examiner cites to WO 93/19792 (Baxter et al.), which discloses

a two part peritoneal dialysis solution, the first part containing an osmotically active substance and carboxylic acid anions, and the second part containing a solution of bicarbonate ions and an amino acid or peptide component. According to the Examiner, the Baxter reference demonstrates that the features shared by the claims cannot be considered “special technical features”.

Applicants respectfully disagree. Nevertheless, in order to be fully responsive, Applicants elect species (i) designated by the Examiner with traverse. Specifically, Applicants elect the Examiner’s designated species “an adsorbent cartridge that traps carbonyl compounds with a carbonyl compound-trapping agent” with traverse. Hereinbelow, Applicants most respectfully point out reasons for the traversal and humbly request reconsideration of the Election of Species Requirement.

Reason One: Species recited within the specification and dependent claims have been addressed

According to the MPEP, unity of invention should be considered only in relation to the independent claims. If the independent claims avoid the prior art and satisfy the requirements of unity of invention, no problem of lack of unity should arise with respect to any claims that depend therefrom. In particular, it does not matter if a dependent claim itself contains a further invention. Equally no problem arises in cases of a genus/species situation where the genus claim avoids the prior art. (MPEP, PCT Administrative Instructions).

For the present application, only claims 20, 21, 27 and 29 are independent. Therefore, the unity of invention test should be limited to these four claims. The fact that the specification and dependent claims set forth what the Examiner considers to be distinct species, should not be relevant. Hence, Applicants respectfully submit that the requirement to select one species from one of groups (1)-(31), set forth on page 8, line 20 to page 10, line 15 of the specification” is not proper because (i) species should be defined by the claims and not by the specification, and (ii) lack of unity should not arise even if dependent claims recite several species.

Reason Two: The claimed invention is *not* anticipated by the Baxter reference

Applicants claimed invention includes reducing highly reactive carbonyl compounds within a peritoneal dialysate thereby eliminating the problem of carbonyl stress. However, the Baxter reference cited within the Office Action is unconcerned about reducing highly reactive carbonyl compounds and eliminating the problem of carbonyl stress. More specifically, Baxter appears to be directed towards providing a stable two-part dialysate that operates at neutral pH buffered between 7.0 and 7.6. In accordance with the system disclosed by Baxter, the bicarbonate ions act as pH buffers and not as carbonyl compound trapping agents. Accordingly, the bicarbonate ions of the Baxter system do not reduce carbonyl stress.

Moreover, Baxter fails to disclose steps required by the independent claims of the present application.

Namely, with respect to independent claim 20, Baxter does not disclose “passing a peritoneal dialysate through an adsorbent cartridge that traps carbonyl compounds within peritoneal dialysates”.

With respect to independent claim 21, Baxter does not disclose “(a) contacting the peritoneal dialysate with a carbonyl compound-trapping agent; and (b) separating the peritoneal dialysate from the carbonyl compound-trapping agent”.

With respect to independent claim 27, Baxter does not disclose “passing a peritoneal dialysate through an adsorbent cartridge comprised of a carbonyl compound-trapping agent; and allowing the carbonyl compounds to be trapped by the agent thereby reducing the carbonyl compounds in the peritoneal dialysate”.

With respect to independent claim 29, Baxter does not disclose “passing a peritoneal dialysate through an adsorbent cartridge comprising at least one carbonyl compound-trapping agent; allowing carbonyl compounds to remain in contact with the adsorbent cartridge for a period of time and under conditions so as to allow carbonyl compounds present in the peritoneal dialysate to bind to the adsorbent cartridge; and recovering peritoneal dialysate having a reduced carbonyl compound content as compared to peritoneal dialysate entering the adsorbent cartridge”.

Accordingly, each of the independent claims 20, 21, 27 and 29 are believed to be

patentable over prior art including Baxter as they share a “special technical feature” which distinguishes them from the prior art thereby allowing these claims to be examined within a single group.

Independent claim 29 is now amended to clearly recite the use of an adsorbent cartridge “comprising at least one carbonyl compound-trapping agent”. Upon this amendment, it is clear that the elected independent claims do all require the step of contacting the peritoneal dialysate with at least one carbonyl compound-trapping agent, wherein the carbonyl compound-trapping agent reduces the level of carbonyl compounds in the peritoneal dialysate. This shared step comprises the “special technical feature” that distinguishes the present invention from the prior art. Thus, as all the independent claims share the same or corresponding “special technical features” and therefore, unity of invention does indeed exist among the claims.

Therefore, Applicants respectfully request the Examiner to reconsider the Election of Species Requirement and to kindly examine all the claimed inventions together.

Applicants have made a diligent effort to completely and fairly respond to the election of species requirement put forth in the Office Action of June 11, 2003. If for any reason the Examiner believes that further communication is necessary on this matter, the Examiner is respectfully requested to contact the undersigned attorney at the indicated telephone number to arrange for an interview to expedite disposition of this application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number SHIM-008.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: _____

21 August 03

By: _____

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